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| APPLICATION NO | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO |
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| 09 622,454     | 11 15 2000  | Louise Bailey        | 57,0291 US PC       | 5454            |

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EXAMINER

TUCKER, PHILIP C

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1712     | S            |

DATE MAILED: 04 24 2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

|                 |           |                |        |
|-----------------|-----------|----------------|--------|
| Application No. | 622454    | Applicant(s)   | BAILBY |
| Examiner        | P. TUCKER | Group Art Unit | 1712   |

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

- Responsive to communication(s) filed on \_\_\_\_\_.
- This action is **FINAL**.
- Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- Claim(s) 9 - 25 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) 9 - 13, 15 - 25 is/are rejected.
- Claim(s) 14 is/are objected to.
- Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on \_\_\_\_\_ is approved disapproved.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

### Attachment(s)

- Information Disclosure Statement(s), PTO-1449, Paper No(s). 7  Interview Summary, PTO-413
- Notice of Reference(s) Cited, PTO-892  Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 17-25 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to teach that the R groups are groups of non-polymeric character. The addition of such to the claims adds new matter to the claims.

3. Claims 17-25 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the definition of the R groups in claim 9, does not reasonably provide enablement for the R groups being of nonpolymeric character. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or the invention commensurate in scope with these claims. The claims are far broader in scope than applicants teaching in the specification. Applicants teaching would include groups such as organometallic groups, silicon containing groups, etc., which are not enabled by the

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specification. Furthermore, the prior art of drilling fluids containing phosphorous compounds is not replete with the teaching of groups of “nonpolymeric character”, to determine the scope of such term. One of ordinary skill in the art would require undue experimentation in order to determine the how to make such compounds, and to determine which of the infinite array of possible compounds would have utility in the present invention..

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 15, 16 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 15 and 16 depend from cancelled claim 1.

In claim 22, it is not clear what is meant by the term “reactive anionic”.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

7. Claims 9, 10, 13, 15, 16, 17, 21, 22 and 25 rejected under 35 U.S.C. 102(e) as being clearly anticipated by Malchow (5807811).

Malchow teaches a water based drilling fluid which comprises a phosphite according to the present invention and weighting agents, viscosifiers, filtration control agents and shale stabilizers (see example 3). The present invention is thus anticipated by Malchow.

8. Claims 9-12, 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by GB 2293373.

GB '373 teaches the use of phosphonocarboxylic acid compounds, along with clays, such as bentonite, and weighting agents which can be used in drilling fluids (page 2, lines 7-17, page 6, lines 15-17 and page 4, line 9). Bentonite acts both as a viscosifying agent and filtrate reducing agent. The present invention is thus anticipated by GB '373.

9. Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tucker whose telephone number is (703) 308-0529. The examiner's normal working hours are 7:30am-4:00pm, Monday-Friday. If necessary SPE Robert Dawson may be contacted at 703-308-2340. For inquiries of a general nature call the receptionist at 703-308-0651. The group FAX no. is 703-872-9310. The **after final** fax no. is 703-872-9311.

PCT-2426  
April 22, 2002

  
**PHILIP C. TUCKER**  
**ART UNIT 1712**